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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/937,845	01/28/2002	Manfred Wiedemer	P01,0318	7063

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SCHIFF HARDIN, LLP
PATENT DEPARTMENT
6600 SEARS TOWER
CHICAGO, IL 60606-6473

EXAMINER

GRANT II, JEROME

ART UNIT	PAPER NUMBER
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2625

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/18/2006	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/937,845

Applicant(s)

WIEDEMER, MANFRED

Examiner

Jerome Grant II

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22-44 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 22,23, 26-34 and 36-39 is/are rejected.
- 7) ☒ Claim(s) 24,25,35 and 40-44 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

JEROME GRANT
PRIMARY EXAMINER

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____.

Detailed Action

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 22, 23, 26-29, 32-34, 36, 38 and 39 are rejected under 35 U.S.C. 102(e) as being anticipated by Kitada et al.

With respect to claim 22, Kitada teaches a device, shown by figure 3, for processing and printing, comprising: a storage device 69 as claimed; a search device 62 as claimed; a printing device (user's printer attached to PC 80 according to paragraph 42); a data network (55) as claimed; search criterion module(document manager 60) having input for search terms (paragraph 38 lines 8-15); a print copy scope module (60) for defining a scope of print copy (see paragraph 37, lines 1-6) so that a search is implemented according to the criterion of search terms that have been input (via user 70 inputting the criteria described at col. 38, lines 11-14 and col. 40, lines 11-13).

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With respect to claim 23, Kitada teaches a formatting device (user 70 and manager 60), see col. 38, lines 11-14, as claimed.

With respect to claim 26, Kitada teaches the Internet as the data network. See paragraphs 4 and 29, see also figure 2.

With respect to claim 27, see figure 2.

With respect to claim 28, the data bank 64 is the storage device.

With respect to claim 29, Kitada teaches a method for processing and printing information, comprising the steps of: searching information at a search station 62 in combination with consulting device 67, that is connected via a data network 50, at least one information storage device 64, according to search criterion inputted by user 70; formatting device (user 70 and manager 60), see col. 38, lines 11-14; and printing step implemented by printing device (user's printer attached to PC 80 according to paragraph 42) for printing the print copy.

With respect to claim 32, Kitada teaches outputting a message of an anticipated cost of a printed copy order (see paragraph 32 (entire), para. 33 (middle) and para. 34 (bottom), regarding the cost of printed copy order and receiving a confirmation of the order, see para. (33 bottom)).

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With respect to claim 33, Kitada teaches formation of documents, according to the top of para. 37. The binding feature is inherently a stapling process known in high-end performance printers and copiers.

With respect to claim 34, it is inherent within the Kitada that the definite range of criterion is set by the user. Results outside the criterion are not regarded.

With respect to claim 36, the ambiguities are criterion not designated by the operator.

With respect to claim 38, Kitada teaches sending identified search results from a user 70 to a storage device 64 to a search station, 62 from an interrogation (document manager 60 or device 67) following an interrogation of said information storage device 64 with search terms (search criterion).

With respect to claim 39, Kitada teaches the search results from consulting device 67 in the search station

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2.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 30, 31, 37 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kitada further in view of Lee (2002/0138475).

With respect to claims 30 and 31, Kitada teaches all of the subject matter upon which the claim depends except for the upper and lower limits as claimed according to the search criterion.

Lee teaches defining a lower and upper limit value (alphabetical or ordered results) for data quantity to be searched according to a criterion (explained at para. 21 and 32); and setting the data quantity (single grouping of search results, according to paragraph 32, at the bottom).

Since, Kitada and Lee are related in that they both use search criteria to search for different documents, the purpose of setting an upper and lower limit would have been recognized by Kitada as set forth by Lee.

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It would have been obvious to modify manager 60 of Kitada to include software or hardware of Lee for implementing the setting of the upper and lower limits for determining the quantity of the data that is desired for searching and printing as clearly set forth by Kitada.

With respect to claim 37, Kitada teaches all of the limitations upon which the claim depends except for the use of synonyms.

However, Lee teaches IP Thesaurus module 312 for providing synonyms as well as Boolean (OR) operator for allowing the user to provide synonyms.

Since Kitada and Lee are both directed toward search criterion, the use of a Thesaurus module would have been contemplated by Kitada for providing synonyms for searching.

It would have been obvious to one of ordinary skill in the art to modify the manager 60 of Kitada so that it is connected to a synonym module for providing synonyms according to the search strategy that a user 70 determines (according to Kitada) as set forth by Lee.

With respect to claim 39, see search results (consulting element 67). See also the middle of para. 38.

3.

Claims Objected

Claims 24, 25, 35, 40-44 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

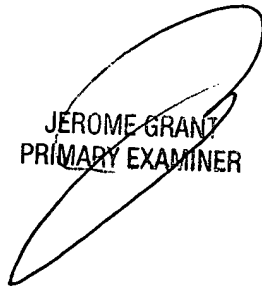
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4.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerome Grant II whose telephone number is 571-272-7463. The examiner can normally be reached on Jerome Grant II from 9:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore, can be reached on 571-272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



JEROME GRANT
PRIMARY EXAMINER